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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Muneki Shimada

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EXAMINER

LEMMA, SAMSON B

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/079,935	SHIMADA ET AL.	
	Examiner	Art Unit	
	Samson B. Lemma	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11, 13, 14, 27 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13, 14, 27 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/10/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This office action is in replay to an amendment filed on April 10, 2006.
Claims 5, 12, 16-26 have been previously canceled. Independent claims 15 and 28 are now canceled. New claims 30-33 are added.
Thus, **claims 1-4, 6-11, 13-14, 27, 29-33** are pending/examined.

Information Disclosure Statement

2. Applicants request for the consideration of the Information Disclosure Statement filed on April 10/2006 is acknowledged. Examiner has reviewed and signed copies of the IDS submitted.

Response to Arguments

3. Applicant's remark/arguments filed on April 10, 2006 regarding independent **claims 1, 10, 27, 29** and the dependent claim 9 have been fully considered but they are not persuasive.

Applicant first argument is based on the limitation in the independent claim 1, 10, 27 and 29.

Applicant argument is based on the motivation used to combine the two references used towards the independent claims **1, 10, 27 and 29**. Applicant argued that, the motivation for modifying/combining **Akiyama (U.S. Patent No. 5,805,699)** with **Qawami (U.S. Publication No. 2002/0176575)** is improper because it lacks supporting evidence.

Examiner disagrees with this argument, Examiner would point out that It is not necessary that the reference actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The text for

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combining references is what the references as a whole would have suggested to one of ordinary skill in the art. See *In re Sheckle*, 168 USPQ 716 (CCPA 1971) *In re McLaghin* 170 USPQ 209 (CCPA 1971). *In re Young* 159 USPQ 725 (CCPA 1968).

In order to clarify how each and every limitation of the independent claims is disclosed by the combination of the two references, namely **Akiyama** and **Qawami** (Examiner would map each limitation of the independent claims with the references used in the rejection as follows). **Referring to the independent claims 1, 10 and 27, Akiyama discloses a copy management system, comprising:**

a storage media, which is stored with predetermined content,[figure 1 reference "1"] **and which is attached with unique media identification information;** [figure 1, reference 2]

a user terminal device, [figure 1, reference 3] **which comprises copy means** [figure 1, reference 9] **for copying the content stored in the storage media** [figure 1, reference 1] **to a first storage device,**[figure 1, reference 3] (Target storage medium) and **which transmits device identification information attached to the user terminal device.**[figure 1, reference 4] (the device identification information/storage medium identifier) together with the unique media identification information of the storage media[column 7, lines 42-45](As explained in the abstract and also column 7, lines 42-45 both the device identification information attached to the user device/ medium identifier shown on figure 1, ref. 4 and the unique media identification which is shown on figure 2, ref. 2 are transmitted /sent to the central site/server device which manages licenses for the right to copy software product); a server device which shown on figure 1, ref. 5) **which transmits copy enabling information for enabling copy of content corresponding to the unique media identification**

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information against the user terminal device corresponding to the device identification information when receiving the unique media identification information and device identification information.[Abstract and column 7, lines 39-column 8, line 7]

Akiyama does not explicitly disclose

- deleting the copy enabling information after copying the content.

However, In the same field of endeavor, **Qawami** discloses

- In step 225, a portion of the track is played back. This portion may be in any of the files that comprise the track. In step 225a, the media unique key (K.sub.mu) is calculated once again. **In step 225b, the encrypted title key stored in local memory is decrypted.** Then, in step 225c, the title key is used to decrypt the content from the buffer of device 15 containing content from the user area 41 of card memory card 13. **Immediately after the buffer is decrypted, the title key is deleted in step 225d and the media unique key is deleted in step 225e.** The order of steps 225d and 225e is not important, but **it is important that both keys are only exposed for the time it takes to completely read/copy a portion of the track. Thus after the track is read/copied the key is deleted. [Paragraph 0058 and also see claim 1]**

The motivation to combine the two references is explained below.

Therefore all the limitations of the independent claims are undoubtedly disclosed by the combination of the references and the rejection is maintained until the applicant amend the independent claims and successfully overcome the rejection without introducing new matters.

The above argument is applicable towards the applicant's argument presented to the independent claims 29.

The next argument presented by the applicant is towards the dependent claims.

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Examiner disagrees with the argument as the dependent claims stands and falls with the corresponding independent claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-4, 6-11, 13-14, 27 and 29-33** are rejected under 35 U.S.C. 103 (a) as being unpatentable over Akiyama et al (hereinafter referred as Akiyama) (U.S. Patent Number:5,805, 699) Date of Patent. (September 8, 1998) in view of Qawami et al (hereinafter referred to as **Qawami**) (U.S.Patent **2002/0176575 A1**)(Claims priority of provisional application 60/251,731) (filed on Dec 7, 2000)

6. **As per claims 1, 3, 10 and 27, Akiyama discloses a copy management system, comprising:**
a storage media, which is stored with predetermined content,[figure 1 reference "1"] **and which is attached with unique media identification information;** [figure 1, reference 2]
a user terminal device, [figure 1, reference 3] **which comprises copy means** [figure 1, reference 9] **for copying the content stored in the storage media** [figure 1, reference 1] **to a first storage device,**[figure 1, reference 3] (Target storage medium) **and which transmits device identification information attached to the user terminal device.**[figure 1, reference 4] (the device identification

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information/storage medium identifier) together with the unique media identification information of the storage media[column 7, lines 42-45](As explained in the abstract and also column 7, lines 42-45 both the device identification information attached to the user device/medium identifier shown on figure 1, ref. 4 and the unique media identification which is shown on figure 2, ref. 2 are transmitted /sent to the central site/server device which manages licenses for the right to copy software product); a server device which shown on figure 1, ref. 5) **which transmits copy enabling information for enabling copy of content corresponding to the unique media identification information against the user terminal device corresponding to the device identification information when receiving the unique media identification information and device identification information.**[Abstract and column 7, lines 39-column 8, line 7]

Akiyama does not explicitly disclose

- deleting the copy enabling information after copying the content.

However, In the same field of endeavor, **Qawami** discloses

- In step 225, a portion of the track is played back. This portion may be in any of the files that comprise the track. In step 225a, the media unique key (K.sub.mu) is calculated once again. **In step 225b, the encrypted title key stored in local memory is decrypted.** Then, in step 225c, the title key is used to decrypt the content from the buffer of device 15 containing content from the user area 41 of card memory card 13. **Immediately after the buffer is decrypted, the title key is deleted in step 225d and the media unique key is deleted in step 225e.** The order of steps 225d and 225e is not important, but **it is important that both keys are only exposed for the time it takes to completely read/copy a portion of the track. Thus after the track is read/copied the key is deleted.** [Paragraph 0058 and also see claim 1]

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It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of deleting the copy enabling information/key after copying the content as per teachings **Qawami** into the method as taught by **Akiyama** in order to limit the number of times the content can be used.

7. **As per claims 14 and 29, Akiyama** discloses a copy management method comprising the steps of:

transmitting/receiving device identification information which is attached to a device that includes a user terminal device, and media identification information uniquely attached to a storage media stored with predetermined content, the media identification information and the device identification information being sent from the user terminal device; [Column 7, lines 42-45] a step of detecting whether the received media identification information is registered in a database registered with media identification information of storage media having the content thereof copied in a state of being associated with device identification information; .[column 7, lines 46-47; figure 7, reference "S12"] and a step of transmitting copy enabling information for enabling copying of the content to a user terminal device when non-registration of the media identification information is detected.[figure 7, reference "S14" and column 7, lines 46-47; figure 7,reference "S12"](Before the copy enabling information for enabling copying of the content is sent to a user terminal device or the target device, the legitimacy of the media identifier/software identifier is checked at the server by checking the registration as explained on column 7, lines 46-47, this meets the recitation of either checking whether the registration of the identifier or checking the non-registration of the identifier depending on the design choice. Then the processing of transmitting the copy enabling information from the central server to the

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terminal device depending on the outcome of verification of the registration proceeds as shown on figure 7, reference S13-S17 and explained on column 7, lines 48-column 8, line 8]

Akiyama does not explicitly disclose

- deleting the copy enabling information after copying the content.

However, In the same field of endeavor, **Qawami** discloses

- In step 225, a portion of the track is played back. This portion may be in any of the files that comprise the track. In step 225a, the media unique key (K.sub.mu) is calculated once again. **In step 225b, the encrypted title key stored in local memory is decrypted.** Then, in step 225c, the title key is used to decrypt the content from the buffer of device 15 containing content from the user area 41 of card memory card 13. **Immediately after the buffer is decrypted, the title key is deleted in step 225d and the media unique key is deleted in step 225e.** The order of steps 225d and 225e is not important, but **it is important that both keys are only exposed for the time it takes to completely read/copy a portion of the track. Thus after the track is read/copied the key is deleted. [Paragraph 0058 and also see claim 1]**

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of deleting the copy enabling information/key after copying the content as per teachings **Qawami** into the method as taught by **Akiyama** in order to limit the number of times the content can be used.

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8. **As per claim 2, Akiyama discloses a copy management system, as applied to claims above. Furthermore Akiyama discloses the system** wherein the server device transmits the copy enabling information only once against one media identification information.[Abstract]

9. **As per claims 4 and 11, Akiyama discloses a copy management system, as applied to claims above. Furthermore Akiyama discloses the system** wherein the server device transmits the copy enabling information encrypted by the device identification information, and the user terminal device decrypts the encrypted copy enabling information with the device identification information.[figure 7, ref. S13-S15]

10. **As per claims 6 and 13, Akiyama discloses a copy management system, as applied to claims above. Furthermore Akiyama discloses the system** wherein the server device transmits an encryption key for encrypting the content to be copied; the user terminal device encrypts the content using the encryption key and copies the encrypted content to the first storage device, stores the encryption key in a predetermined storage means, and decrypts the content copied to the first storage device with the encryption key. [Figure 7]

11. **As per claim 7, Akiyama discloses a copy management system, as applied to claims above. Furthermore Akiyama discloses the system** wherein the server device stores as media identification information that transmission of the copy enabling information is complete in a database, in a state of being associated with device identification information attached to each user's user terminal device, and overwrites old device identification information registered in the database with modified device identification information when the device identification information of the user terminal device is modified due to repair or exchange.[Figure 1, reference "user profile database"; column 7, lines 47-48; the

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registration of software identifier is disclosed and overwriting and modifying of old identification such as software identifier DID should be inherently included in the database registration]

12. **As per claim 8-9, 30-32** Akiyama discloses a copy management system, as applied to claims above. Furthermore Akiyama discloses the system wherein the server device performs predetermined charge processing against a user who owns the user terminal device to which transmission of the copy enabling information is performed.[figure 8, see "request for billing"]

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

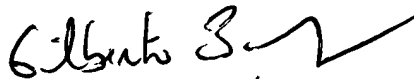
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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S.L.
06/16/2006


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